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1 RECORD OF ORAL HEARING
2 UNITED STATES PATENT AND TRADEMARK OFFICE
3

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex Parte* MICHAEL D. ZOECKLER
8

9 Appeal 2010-005635
10 Application 09/559,704
11 Technology Center 3700
12

13 Oral Hearing Held: May 10, 2012
14

15 Before JENNIFER D. BAHR, LINDA E. HORNER, and STEVEN D.A.
16 McCARTHY, *Administrative Patent Judges.*

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2 The above-entitled matter came on for hearing on Thursday, May 10,
3 2012, commencing at 10:10 a.m., at the U.S. Patent and Trademark Office,
4 600 Dulany Street, Alexandria, Virginia, before Tania Kendall, a Notary
5 Public.

6 P R O C E E D I N G S

7 THE USHER: Calendar No. 57, Appeal No. 2010-5635,
8 Mr. Quinalty.

9 JUDGE BAHR: Thank you.

10 THE USHER: Uh-huh.

11 MR. QUINALTY: Good morning.

12 JUDGE BAHR: Good morning. Do you have a business card for
13 the --

14 MR. QUINALTY: I do. Do you want one, as well?

15 JUDGE BAHR: You can start whenever you're ready.

16 MR. QUINALTY: Okay.

17 JUDGE BAHR: And we don't need it, sir.

18 MR. QUINALTY: Good morning.

19 JUDGE HORNER: Good morning.

20 JUDGE BAHR: Good morning.

21 MR. QUINALTY: Just start whenever I'm ready? Okay. This, we're
22 back before you, a couple of you. Last time, my esteemed colleague,
23 Mr. Calvert, your former colleague, argued this case. This is a case, an
24 application involving a method of making cartons, and the cartons have
25 blanks that are formed of a non-corrugated paperboard, which provided hand
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1 strength and rigidity similar to a product called microflute.

2 We have two independent claims. They're both method claims, and
3 they are ribbons of a reinforcing material such as paperboard which are
4 laminated to selected panel portions of a moving web of non-corrugated
5 paperboard. The panel portions are then separated by longitudinal fold lines
6 and subsequently become a number of panels when the carton blanks are
7 formed from the web.

8 Each ribbon -- there's a first and a second ribbon -- overlies and is
9 adhered to substantially all of a panel portion to which it's adhered, but it
10 does not extend across that longitudinal fold line. I have a couple of
11 handouts to show. May I approach?

12 JUDGE HORNER: Yes, sir. Thank you.

13 JUDGE BAHR: Thank you.

14 MR. QUINALTY: So what I have highlighted in green is, there's
15 three figures from our spec, Figs. 3, 6-A and 8. And I've highlighted the
16 reinforcing ribbons, if you notice on Fig. 3, the panel portions we're talking
17 about, the -- what end up being the top and the bottom end flaps and the
18 reinforcement is what I've highlighted in green. And then that's also shown
19 in Fig. 6-A, and Fig. 6-A shows that the reinforcement is actually up to a, to
20 cover substantially all of that panel portion, but a specified distance away
21 from the fold line, so that it will not interfere with the folding.

22 And same thing in Fig. 8, there's actually a 123 is adhered to the side
23 panels 117 and there's one on the other side I actually highlighted in green,
24 another flap in there. But we're talking specifically about the 123, which is
25 on the inside, reinforcing the side panels.

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1 JUDGE BAHR: I'd like to interrupt you for just a minute.

2 MR. QUINALTY: Yes.

3 JUDGE BAHR: In Figure 2, there are some other -- Figure 2 of the
4 application there are some other strips 21, which are -- appear not to cover
5 substantially the entire panel. Are those not the types of strips you're -- or
6 ribbons you're referring to in the claims?

7 MR. QUINALTY: Those are not the ones that we're referring to in
8 the claims, but those are additional areas where specifically, for where
9 strength is desired. And it could be for, depending on the packaging or
10 whatever is put inside the actual container. But these claims are specifically
11 drawn to the ones, the reinforcing ribbons that cover substantially all of the
12 panel portions.

13 JUDGE BAHR: Thank you.

14 MR. QUINALTY: So like I said, these are method claims, and once
15 the ribbon is placed on, the web subsequently is cut to form carton blanks
16 which can then be formed into cartons. Now, as I said, this case has been
17 before you with slightly different claims and then was overturned, the
18 Examiner's rejection. And the Examiner reopened prosecution, applied new
19 art, and we've moved back through. This is a case history of Amendments if
20 you -- this case was filed 12 years ago. It's very interesting to go back
21 through.

22 But basically, the Examiner has two base references, *Walsh* and
23 *McNown*. *McNown* was added in the Examiner's Answer, and we've replied
24 to that in our Reply Brief. But let's talk about *Walsh* first. *Walsh* is -- and I
25 have some more demonstratives. If you go to the third one, and I've written
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1 on the bottom, it's from *Walsh* 871, and there's three different figures, 2, 5,
2 3 and 9.

3 But basically, *Walsh* takes a web, which is 2, shown in Fig. 2, takes a
4 web and has three rollers. And they take a web 2 and then they put on some
5 kraft paper and adhere it with some film and then roll it out. And I've sized
6 these. We took this from the actual Appeal Brief, but I've just -- I've added
7 this red line just to show you. But what you basically have is a doublewide
8 web, and the web is then sliced right down the middle. And so, this
9 becomes the top portion and the bottom portion, which will cover these
10 areas.

11 And 10, which is the film, will eventually basically become this, make
12 cereal boxes. And then they take, put the cereal in and then seal the film.
13 So they want the film to not be perforated, ideally. So this is two blanks.
14 And then I've put Fig. 5, which is an example of one of the blanks, and
15 extended out where 6 approximately would correspond with the blank,
16 which is cut subsequently. So that's the basic *Walsh*. And if you look at, I
17 also gave you another one which shows where the film 10 is over the web
18 and where it actually adheres to the web and where it does not adhere, which
19 is at 6. I highlighted those in blue.

20 So there's a number of problems with *Walsh*. *Walsh* is used as an
21 anticipatory reference under 102 and then is used as an obviousness rejection
22 under 103. But in the rejections for *Walsh*, the Examiner indicates that,
23 quote, that well, that *Walsh* is unclear, quote "as to the exact positioning of
24 the ribbons of reinforcing material with respect to the fold lines 54." As you
25 well know, there's no anticipation if the reference is unclear, but he
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1 continues to maintain his anticipatory rejection.

2 And I wanted to point out one other, wait. So the last figure that I've
3 included is Fig. 6, and -- I'm sorry, Fig. 9, which shows 6, which is the film,
4 and I'm on the top section of the blank here. And there's a little cut-out
5 portion which is at -- we highlighted this, also, from our -- I think this is in
6 the Reply Brief -- and 6 is, if it extended short of the fold line 54, it would
7 have shown as a line, A, which it doesn't show in actual Fig. 9. And if that
8 were true, there would be sticky from the film 10, which is here, which
9 would stick to the -- I'm sorry, I said that backwards. There would be
10 adhesive from 10, which would stick to the film when it was pulled out of
11 there.

12 So this little part is not shown in the actual figures. So neither
13 rendering of *Walsh* actually shows that the reinforced -- I'm sorry, the kraft
14 paper extends below that fold line. So no disclosure of *Walsh* shows that.
15 That's one. Two, *Walsh* doesn't actually show all the claimed elements.
16 Specifically, both independent Claims 1 and 25 are method claims, and in --
17 *Walsh* does not disclose, in addition to showing it doesn't extend across the
18 fold lines, it does not disclose actually forming the longitudinal fold lines in
19 the web, which is something we claim. It's just not specific about that.
20 These are cut in later and form blanks. So the method step of forming
21 longitudinal fold lines is not shown in *Walsh*.

22 There were several other points that we've made about *Walsh*. One,
23 the ribbons 6 are not actually adhered to the web. That rejection was
24 actually first made in 2002, and -- based upon *Walsh*, and we traversed that
25 and said that the reinforcing ribbons are not adhered to the web, as was
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1 claimed even then. There was an interview that was done with the
2 Examiner, the primary set in and the primary then issued in interview
3 summary that said quote, "the strip 6 are not directly adhered to paperboard
4 material. Claim 1 calls for adhering strips to paperboard. Applicant has
5 agreed to file a request for reconsideration."

6 The rejection based on *Walsh* were then withdrawn, and *Stone* and a
7 couple other references, which was the point of the last hearing, were then
8 applied. So then after that was done, we've now reapplied *Walsh*. So they
9 are not -- 6 is not adhered to 2, and in fact, it's specifically not supposed to
10 be adhered to 2, or the film would stick at places and you would rip the liner.

11 And one other point: *Walsh* doesn't teach reinforcing. We talked
12 about this a number of times in the brief. And the same -- even in the same
13 interview summary, the Examiner said *Walsh* does not reference -- does not
14 provide a reinforcing material. *Walsh*, itself, says we do not provide a
15 reinforcing material in column 1, lines 12 or 15. I can find that.

16 So *Walsh* -- there's also, there's one other reference that's combined
17 with *Walsh* under 103. I can find that reference real quick. I saw perplexing
18 looks. From the background of the invention, column 1, line 14 starts out
19 and says that it is not secured to the paperboard. So *Walsh* specifically says
20 that those areas are not secured to the paperboard. So it does not anticipate,
21 and there's no teaching for rendering it obvious, as is shown in my
22 demonstratives. So the other reference, *Decottignies*, does not improve
23 *Walsh* at all, and therefore, I think the references, the rejections based on
24 *Walsh* should be withdrawn.

25 Then we move on to *McNown*, which as I noted, was initially cited as
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1 a base reference in the new ground of rejection in the Examiner's Answer.
2 We traversed the new ground of rejection in the Reply Brief, but the
3 Examiner did not answer our arguments and instead, just indicated the Reply
4 Brief was considered it entered. For that reason alone, as we indicated, the
5 new rejections based on *McNown* should be summarily reversed. The
6 Examiner did not reject them, our objections.

7 But instead of waiving that, I'd like to go on and address *McNown*,
8 which is a very strange reference. *McNown* also fails to disclose all the
9 elements of independent Claims 1 and 25, even if it is combined with *Walsh*.
10 And it fails to make up for the -- *Walsh* fails to make up for the inadequacies
11 of it. *Walsh* only teaches the use of reinforcing laminations on what it shows
12 is a panel made of corrugated material, contrary to the appealed claims,
13 which require a web of non-corrugated paperboard.

14 *McNown*, as you'll notice, also does not disclose a web and does not
15 disclose advancing a web of paperboard having longitudinal panel portions
16 or -- which are made by longitudinal fold lines. So that element is not
17 shown by any of these references. Interestingly, *McNown* shows what
18 appears to be three embodiments. One is a full lamination, so you have a
19 panel of corrugated material that is laminated on the top, and then you have
20 a second -- that's clearly not us, because it extends across the fold lines.

21 Then you have another one where it says specifically lamination is --
22 extends across the fold lines, and they have two different ribbons that extend
23 on. And then a third embodiment, which is the closest to being applicable,
24 but the Examiner's not explained how he's applying -- he actually combined
25 the second and the third ones in his rejection. The problem with the third
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1 rejection is that there is no specifics as to how far this, whatever this inside
2 the score line, means. And as the Board pointed out last time, we're not
3 even certain that this would read on substantially all, and that was
4 interpreted by the Board to mean "A predetermined short distance selected
5 to allow unimpeded folding of the carton blank while maximizing structural
6 reinforcement."

7 There's no disclosure as to how far that is inside that line. Plus, the
8 claims specify -- that's another point -- the claims specify that there's a first
9 and a second ribbon, each of which cover substantially all of, but not beyond
10 a panel portion. If you'll notice on here, even if you called this a first ribbon
11 and that a second ribbon, neither one of them cover substantially all of the
12 panel portion, and there's only panel. So for at least those reasons, *McNown*
13 does not seem to be any better of a reference, and maybe a worse reference,
14 than *Walsh*.

15 There were a few other references. I believe the Examiner cited three
16 new references in the Examiner's Answer. Those probably just -- I have not
17 dealt with those. I think that the Board should probably just not apply those
18 rejections. Not apply those, because those rejections were not made. And I
19 think that's -- I guess so. *Decottignies* is a reference that -- let me see if I
20 can find my copy -- is a reference the Examiner has urged combining with
21 *Walsh*.

22 *Decottignies* has a -- is a label-making machine for the outside of
23 panels, and they make these labels onto parallelepipedal containers that will
24 then coat the outside so that you can make the cereal box with these
25 portions. And the Examiner has urged that combining *Walsh* with
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1 *Decottignies* will reach a couple of our claims. The problem is the
2 combination of this, *Decottignies*, applies to the outside of the panel portions
3 that are folded around to make the box, and then he says you can combine
4 that printed label with this printed label, which, as you'll notice in my
5 example, Fig. 3, is inside the film. So it's actually applying an outside
6 coating, and he's urging you would combine that with the inside of *Walsh*,
7 which we think is improper. And that's basically all I have. Any questions?

8 JUDGE BAHR: We have no questions.

9 MR. QUINALTY: Okay.

10 JUDGE BAHR: Thank you.

11 MR. QUINALTY: Thank you very much.

12 (Whereupon, the proceedings, at 10:27 a.m., were concluded.)

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